

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTIN COLE, THOMAS T. HOWARTH and CHRISTOPHER
READING

Appeal No. 98-0573
Application 08/418,055¹

HEARD: May 3, 1999

Before GARRIS, OWENS and LIEBERMAN, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application for patent filed April 6, 1995. According to the appellants, the application is a continuation of Application 07/749,482, filed August 15, 1991; which is a continuation of Application 07/210,339, filed June 23, 1988, now abandoned; which is a continuation of Application 05/569,007, filed April 17, 1975, now abandoned.

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This is an appeal from the examiner's final rejection of claims 36-42, which are all of the claims remaining in the application.

THE INVENTION

Appellants' claimed invention is directed toward purified clavulanic acid and specified purified salts thereof. Appellants state that clavulanic acid and its salts enhance the effectiveness of β -lactam antibiotics against many β -lactamase producing bacteria. Claims 36 and 37 are illustrative and read as follows:

36. Purified clavulanic acid.

37. A purified pharmaceutically acceptable salt of clavulanic acid.

THE REFERENCE

Eli Lilly & Co. (Lilly)	1,315,177	Apr. 26,
1973		

THE REJECTIONS

Claims 36-42 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 35 and 36 of copending Application

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08/417,628 and over claims 36, 37 and 41-45 of copending Application 08/417,625. Claims 36-42 also stand rejected under 35 U.S.C. § 103 as being unpatentable over Lilly.

OPINION

Appellants do not challenge the obviousness-type double patenting rejections. We therefore summarily affirm these rejections. As for the rejection under 35 U.S.C. § 103, we have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that this rejection is not well founded. Accordingly, we do not sustain the rejection under 35 U.S.C. § 103.

The examiner argues that Lilly teaches (page 2, lines 30-31) that the fermentation broth contains "other antibiotic substances" and that since these substances have been found to include clavulanates, and clavulanates have been identified as antibiotics, it would have been *prima facie* obvious to one of ordinary skill in the art to purify the compounds recited in

appellants' claims (answer, page 4).

This argument is not persuasive because the examiner has not established that those of ordinary skill in the art were aware that clavulanic acid or the salts thereof recited in appellants' claims were known in the art to be to be among the "other antibiotic substances" mentioned in Lilly or to have any other

use. Thus, it is not apparent from the record why one of ordinary skill in the art would have been motivated to purify these compounds. The record indicates that the motivation relied on by the examiner for purifying clavulanic acid or its salts comes solely from appellants' specification. Hence, the examiner's rejection is based on impermissible hindsight. See *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960). Accordingly, we do not sustain the rejection under 35 U.S.C. § 103.

DECISION

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The provisional rejections of claims 36-42 under the judicially created doctrine of obviousness-type double patenting over claims 35 and 36 of copending Application 08/417,628 and over claims 36, 37 and 41-45 of copending Application 08/417,625 are affirmed. The rejection of claims 36-42 under 35 U.S.C. § 103 as being unpatentable over Lilly is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

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BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
TERRY J. OWENS))
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
PAUL LIEBERMAN))
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